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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,255	01/09/2001	Richard N. Spann	RNS-001	6555

21323            7590            05/23/2003

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NOVOSAD, JENNIFER ELEANORE

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3634

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HO

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/757,255	SPANN, RICHARD N.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer E. Novosad	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 March 2003.

2a) This action is **FINAL**.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 24-26 and 28-42 is/are pending in the application.

4a) Of the above claim(s) 31-38 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 24-26,28-30 and 39-42 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 03 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

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## DETAILED ACTION

This Office action is response to the amendment filed March 31, 2003 (Paper No. 15).

### *Status of the Claims*

Claims 31-38 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not contain support for the negative limitation, i.e., "lacking means" and "without providing means", in its totality of negative exclusion.

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-26, 28-30, and 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The limitations "lacking any means for supporting the lower end of the elongate member when received between the rails" in lines 5-6 of claim 24 and "without providing means for supporting the lower end of the elongate member when received between the rails" in lines 9-10 of claim 39 appear to be vague and/or indefinite. *In particular*, if the holding device lacks any means for supporting the lower end of the member, how is the lower end maintained within the opening? The developed friction or clamping force is considered to constitute a "means" for supporting the lower end. It is noted that the claims do not require that the lower end of the member, itself, be unsupported.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 25, 39, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Teeney '092.

Teeney '081 discloses a holding device (see Figure 1) comprising a first rail (16) and a second rail (18) vertically and horizontally offset from one another thereby forming an opening therebetween for receiving a lower end of an elongate member therein so that the member (H) is disposed in a generally vertical orientation therein, the holding device, itself, lacking means for supporting the lower end of the member; the rails defining generally parallel crossbars having opposed edges for contacting the member when inserted therein, i.e., the edges do not contact the

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member at the same time. Teeney '092 is considered to teach the structure capable of performing the method steps of positioning rails offset from one another and inserting a lower end of an elongate member into an opening formed between the rails without providing a means on the device for supporting the lower end of the member.

Claims 24, 25, 39, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Foss *et al.* '799.

Foss *et al.* '799 disclose a holding device (30) comprising a first rail (31) and a second rail (32) vertically and horizontally offset from one another thereby forming an opening therebetween for receiving a lower end of an elongate member (40) therein so that the member (40) is disposed in a generally vertical orientation therein, the holding device, itself, lacking means for supporting the lower end of the member; the rails defining generally parallel crossbars having opposed edges for contacting the member when inserted therein. Foss *et al.* '799 are considered to teach the structure capable of performing the method steps of positioning rails offset from one another and inserting a lower end of an elongate member into an opening formed between the rails without providing a means on the device for supporting the lower end of the member.

It is noted that Foss *et al.* are considered to disclose the elongate member "disposed in a generally vertical orientation" in view of applicant's definition of a vertical orientation as ranging "from about zero degrees to about 45 degrees from vertical" (see page 6, lines 16-18).

Claims 24-26, 28-30, and 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Speiser '473.

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Speiser '473 discloses a holding device comprising a first rail (e) and a second rail (d) vertically and horizontally offset from one another thereby forming an opening therebetween for receiving a lower end of an elongate member therein so that the member is disposed in a generally vertical orientation therein, the holding device, itself, lacking means for supporting the lower end of the member, i.e., the inverted member held in between elements e and d is suspended upon e; the rails defining generally parallel crossbars having opposed edges for contacting the member when inserted therein whereby each of the rails is formed with a depression, e.g., d and c (see Figures 4 and 3, respectively) and the depressions being *generally* aligned, i.e., along a vertical line which passes through one depression in each rail, to limit movement, i.e., in a horizontal direction; the device comprising two end plates (A and A') attached to side edges of the crossbars whereby the outward extends of the end plates define a footprint and the vertical projection through a center of gravity of the member lies within the footprint. Speiser '473 are considered to teach the structure capable of performing the method steps of positioning rails offset from one another and inserting a lower end of an elongate member into an opening formed between the rails without providing a means on the device for supporting the lower end of the member.

#### ***Interview Summary/Response to Arguments***

It is noted that the summary of the interview, held on March 26, 2003, between the examiner and Mr. Stamos is not accurate. In the interview, the examiner did state the proposed changes appeared to define over the Pushee reference. *However*, the claims (and hence the case) were not deemed to be allowable at that time, i.e., a claim can define over the prior art of record

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without placing the case in condition for allowance. *Accordingly*, new grounds of rejection are advanced above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703)-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-3597 for regular communications and (703)-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.

  
Jennifer E. Novosad  
Examiner  
Art Unit 3634

Jennifer E. Novosad/jen  
May 19, 2003